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10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861
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			EXAMINER	
			TOMASZEWSKI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3626	
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			01/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/045,649

Applicant(s)

MORIMOTO, NOBUYOSHI

Examiner

Mike Tomaszewski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the Brief On Appeal filed on 9/27/07.

Claims 1-20 are pending.

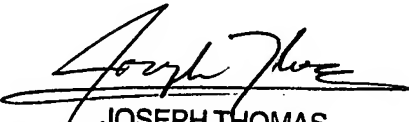
Brief On Appeal

2. In view of the Appeal Brief filed on 9/27/07, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, Appellant must exercise one of the following two options:

- (A) File a reply under 37 CFR 1.111 (if this Office Action is non-final) or a reply under 37 CFR 1.113 (if this Office Action is final); or
- (B) Initiate a new appeal by filing a Notice of Appeal under 37 CFR 41.37. The previously paid Notice of Appeal fee and Appeal Brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Appellant must pay the difference between the increased fees and the amount previously paid.

A supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 8, 12-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Parcel Insurance Plan* (www.pipinsure.com; hereinafter *Pipinsure*), in view of *Keuper* (DE 44 46 203 A1; see English translation; hereinafter *Keuper*), in view of *Luchs et al.* (4,831,526; hereinafter *Luchs*).

(A) As per previously amended claim 1, *Pipinsure* discloses a method for arranging insurance for an item, wherein the method comprises:

- (1) receiving a request *for a quote* to insure the item being shipped from an origination to a final destination (*Pipinsure*: pg. 8);

- (2) searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item (*Pipinsure*: pg. 1);
- (3) generating a data file comprising at least the following:
 - (i) item information (*Pipinsure*: pg. 8); and
 - (ii) insurer information (*Pipinsure*: pg. 8).

Pipinsure, however, fails to expressly disclose a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item; and
- (5) a request to insure.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item (*Keuper*: abstract); and
- (5) a request to insure (*Luchs*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Luchs* with the teachings of *Pipinsure* and *Keuper* with the motivation of insuring items to be shipped (*Luchs*: abstract).

(B) As per original claim 2, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(C) As per original claim 3, *Pipinsure* fails to expressly disclose the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(D) As per original claim 8, *Pipinsure* discloses the method as recited in claim 1, wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item (*Pipinsure*: pg. 2-3).

(E) As per original claim 12, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data tile further comprises item weight information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data tile further comprises item weight information (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(F) As per original claim 13, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item handling information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data file further comprises item-handling information (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(G) As per original claim 14, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item content information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data file further comprises item content information (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(H) As per original claim 15, *Pipinsure* discloses the method as recited in claim 1, wherein the data file further comprises insurance information (*Pipinsure*: pg. 8).

(I) Claim 20 substantially repeats the same limitations as claim 1 and therefore, is rejected for the same reasons given for claim 1 and incorporated herein.

4. Claims 4, 6, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure*, *Keuper*, and *Luchs*, as applied to claim 1 above, and further in view of *Kadaba et al.* (6,285,916; hereinafter *Kadaba*).

(A) As per original claim 4, *Pipinsure* discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to at least one insurance company (*Pipinsure*: pg. 8).

Pipinsure, however, fails to expressly disclose the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination (*Kadaba*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).

(B) As per original claim 6, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server (*Kadaba*: figures 1-10).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).

(C) As per original claim 9, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further

comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (*Kadaba*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).

(D) Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, and 9 and incorporated herein.

5. Claims 5, 7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure*, *Keuper*, and *Luchs*, as applied to claim 1 above, and further in view of Official Notice.

(A) As per claim 5, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to transmit information via a network to an email address. The technique of using networks, such as, the Internet, intranets, wide area networks (WANs), local area networks (LANs), to transmit information across their lines to email addresses

using, *inter alia*, Outlook Express, Hotmail, and Yahoo was notoriously well known and widely used at the time of the present invention and was developed to, *inter alia*, facilitate the transmission and sharing of information.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique of transmitting information via a network to an email address with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of facilitating the transmission and sharing of information.

(B) As per original claim 7, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising shipping the item using the least expensive routing.

Nevertheless, Official Notice is taken that it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing. This technique was well known and widely used at the time of the present invention by, for example, price conscientious consumers striving to minimize expenses and by corporate entities striving to maximize profits/revenue through cost containment.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique shipping items using the least expensive routing with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of minimizing costs/expenses and/or maximizing profits/revenues.

(C) As per claim 10, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein storing the data file comprises data in an XML format.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to store data in eXtensible Markup Language (XML) format. This technique was well known and widely used at the time of the present invention. For example, corporate organizations routinely formatted their documents in XML to create their own customized "tags," thereby enabling the definition, transmission, validation, and interpretation of data between applications and between organizations.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique storing data in XML format with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation facilitating the transmission of data between applications and/or organizations over a network.

(D) As per claim 11, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the network data is exchanged in an XML format.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to exchange network data in an XML format for substantially the same reasons given for claim 10 above and incorporated herein.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure*, *Keuper*, and *Luchs*, as applied to claim 1 above, and further in view of *eBay* (<http://www.ebay.com>; hereinafter *eBay*).

(A) As per original claim 16, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping.

Nevertheless, this feature is old and well known in the art, as evidenced by *eBay*. In particular, *eBay* discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping (*eBay*: Why *eBay* is Safe; How to Add a Photo to Your Item Listing).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *eBay* with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of providing a means for archiving the condition of an item for insurance claims purposes (*eBay*: Why *eBay* is Safe).

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure*, *Keuper*, and *Luchs*, as applied to claim 1 above, in further view of *Chen et al.* (5,504,674; hereinafter *Chen*), and further in view of knowledge generally available to one having ordinary skill in the art.

(A) As per original claim 17, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

Nevertheless, this feature is old and well known in the art, as evidenced by *Chen* and knowledge generally available to one having ordinary skill in the art. In particular, *Chen* discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (*Chen*: abstract). Furthermore, taking photographs of items to document the physical condition of the items at different time frames (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known. For example, customers of parcel carriers, such as, FedEx™ and UPS™, are advised to document (e.g., photograph) any damage to their parcels/goods upon receipt in order to ensure successful insurance claims. Another example involves car rental agencies. Before a customer rents a vehicle from a car rental agency the agency meticulously documents the condition of a vehicle. Upon return of the vehicle, the car rental agency will photograph any damage to their vehicle to maintain the proper documentation for insurance claims purposes.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Chen* and knowledge generally available to one having ordinary skill in the art with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of providing a means for assessing damage for insurance claim processing purposes (*Chen*: abstract).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure*, *Keuper*, and *Luchs*, as applied to claim 1 above, and further in view of *Kepler* (5,347,845; hereinafter *Kepler*).

(A) As per original claim 18, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper* and *Kepler*. In particular, *Keuper* and *Kepler* disclose the method as recited in claim 1, wherein the memory device (*Keuper*. abstract) comprises an air testing device configured to test air samples for contaminants (*Kepler*. abstract; col. 2, lines 25-35) and to store test results in the data file (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure*, *Keuper* and *Luchs* with the motivation of acquiring shipment-handling data on an item (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kepler* with the combined teachings of *Pipinsure*, *Keuper*, and *Luchs* with the motivation of detecting the presence of contaminants in shipping containers (*Kepler*. col. 2, lines 33-35).

Response to Arguments

9. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

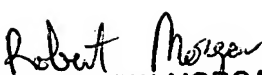
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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